

Docket No.: 50435-015 (P2145)



2132
#25 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

LI GONG

Serial No.: 08/883,636

Filed: June 26, 1997

For: LAYER-INDEPENDENT SECURITY FOR COMMUNICATION CHANNELS

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Group Art Unit: 2132

Examiner: D. Meislahn

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JUL 20 2001

Group 2100

PETITION FOR REVIEW OF A DIRECTOR'S DECISION

Commissioner for Patents
Washington, DC 20231

Sir:

This is a Petition for review the Decision of the Director of Technology Center
2100 denying Applicant's Petition filed April 11, 2001.

This Petition raises issues of consistency of patent prosecution practice
throughout the Examining Corps.

RECENT PROSECUTION BACKGROUND

August 29, 2000 - Office Action mailed. In the art rejection of claims 2, 6, and 14 the Examiner took Official Notice that it is old and well known that encrypting already encrypted data increases security and that encryption is sometimes performed in communication protocols.

November 29, 2000 - Petitioner files response requesting evidence that the asserted features are old and well known.

February 13, 2001 - Office Action mailed. Examiner points out that there has not been an adequate challenge to traverse the Official Notice. Examiner supplies a reference purportedly supporting the assertions made in the Official Notice.

Examiner objects to Figure 3 requesting it be "designated with a legend such as --Prior Art--"

Examiner takes Official Notice of various features the Examiner attributes to Java (§ 14).

April 11, 2001 - Petition filed.

May 14, 2001 - Amendment and Request for Approval of Drawing Amendment filed **complying with all objections not petitioned.**

May 29, 2001 - Decision by the Group Director.

RELIEF REQUESTED

The Petition under 37 CFR §1.181 to the Group Director requested the following relief:

- A. Requiring the Examiner to further elucidate the rejection of August 29, 2000.
- B. Withdrawal of the Drawing Requirement as to Figure 3.
- C. Requiring the Examiner to provide a meaningful reference to support his position on Official Notice.

ARGUMENT

The Group Director upheld the Examiner's taking of Official Notice of August 29, 2000 citing MPEP 2144.03. 2144.03 says that "if the Applicant traverses such an assertion [of Official Notice] the Examiner should cite a reference in support of his or her position."

The Group Director states: "challenging the existence of well known prior art by arguing that the fact is not supported by a reference, without stating that the Examiner is wrong or that Applicant is without knowledge of the prior art teaching does not constitute a proper traverse." [Emphasis Added]

The position of the Group Director is wrong for four reasons:

It assumes that the "prior art" is "well known" in fact which is the very issue in contention in a challenge to Official Notice. Thus, the Group Director assumes his conclusion.

Further, the Group Director appears to be implementing a policy that imposes procedural burdens on an Applicant in order to traverse Official Notice that have not been promulgated to the Patent Bar in general and to Applicant in particular. The Group Director's implementation results in an *ex post facto* application of the Group Director's policy to applicants who have no knowledge of that policy and therefore couldn't comply with it. This is fundamentally unfair.

The Group Director's policy contradicts the requirements of MPEP 2144.03 by taking away rights of the Applicant granted by the PTO.

Further, the position taken by the Group Director is contrary to cases, which put upon the Patent Office the initial burden of proof to make out a *prima facie* case of obviousness. *In re Palmer*, 451 F2d 1100, 172 USPQ 126 (CCPA 1971); *In re Fielder*, 471 F2d, 640, 176 USPQ 300 (CCPA 1973).

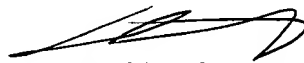
Finally, the Group Director failed to address the other requests for relief contained within Applicant's Petition filed April 11, 2001.

Accordingly, Applicant requests that the position of the Group Director regarding Official Notice be reversed and that the Group Director be directed to consider on the merits the other requests in Applicant's Petition filed on April 11, 2001.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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